

REMARKS

The above-referenced patent application has been reviewed in light of the Office Action referenced above. Applicants gratefully acknowledge the Examiner's indication that claims 9-17 have been allowed. Reconsideration of the above-referenced patent application in view of the foregoing amendments and following remarks is respectfully requested.

Claims 18-20 have been added herein, and therefore claims 1-20 are currently pending. Claims 1-5, 8-9, and 11-14 have been amended. The amendment is fully supported by the original disclosure. No new matter has been introduced. The above amendment were, in many instances, made to clarify Assignee's claims and do not narrow the scope of the amended claims. Furthermore, in many instances, the above amendments broaden the literal scope of claims and/or claim elements. In light of this, Assignee asserts that no prosecution history estoppel should result from the above amendments.

Claim Rejections - § 102

The Examiner has rejected claims 1, 2, 5 and 6 under 35 USC 102(b) based on US Patent No. 5,864,130 to Kahn et al. (hereinafter "Kahn").

Independent claim 1 recites an optical scanner that includes, *inter alia*, "*a carrier having a connecting unit having an optical system mounted thereon*" and "*a casing having a guiding rail, wherein the guiding rail is formed on an interior wall of the casing as an integral unit and the guiding rail has at least a fastener to latch with the connecting unit of the carrier.*" It is submitted that Kahn does not identically disclose this feature. In particular, as can be seen in Figure 1, the Examiner has failed to establish that the track (34) of Kahn includes a fastener to latch with the connecting unit of the carrier, as described in independent claim 1. . In the absence of the Examiner showing that such an element is present in Kahn, Assignee respectfully requests the rejection be withdrawn.

It is therefore submitted that Kahn does not anticipate claim 1 or its dependent claims 2, 5 and 6, for at least the reasons discussed above.

Claim Rejections - § 103

The Examiner has rejected claim 3 under 35 USC 103(a) based on Kahn in view of U.S. Patent No. 4,609,818 to Lennemann (hereinafter "Lennemann").

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955,

1956 (Fed. Cir. 1993). To establish *prima facie* obviousness there must be some suggestion or motivation to modify or combine reference teachings (In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988)) which must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). In addition, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). It is submitted that the cited references do not meet these criteria.

Claim 3 depends from claim 1 and incorporates all of its limitations. The Lennemann patent fails to cure the deficiencies of the Kahn patent at least because it also does not disclose or suggest the limitations of claim 1, namely: “*a casing having a guiding rail, wherein the guiding rail is formed on an interior wall of the casing as an integral unit and the guiding rail has at least a fastener to latch with the connecting unit of the carrier.*” Thus, neither Kahn nor Lennemann, either alone or in combination, teaches all of the elements recited in claim 3. It is noted that many other bases for traversing the rejection exist as well, such as lack of suggestion or motivation to combine, and/or expectation of success. It is therefore respectfully requested that the obviousness rejection of claim 3 be withdrawn.

The Examiner has rejected claims 7 and 8 under 35 USC 103(a) based on Kahn in view of U.S. Patent No. 6,305,608 to Nada et al. (hereinafter “Nada”).

Claims 7 and 8 also depend from independent claim 1. Since the Nada patent similarly fails to cure the above-noted deficiencies of the Kahn patent, as it also does not disclose or suggest *a casing having a guiding rail, wherein the guiding rail is formed on an interior wall of the casing as an integral unit and the guiding rail has at least a fastener to latch with the connecting unit of the carrier*, it is submitted that neither Kahn nor Nada, either alone or in combination, teaches all of the elements recited in claims 7 and 8. It is noted that many other bases for traversing the rejection - exist as well, such as lack of suggestion or motivation to combine, and/or expectation of success. It is therefore respectfully requested that the obviousness rejection of claims 7 and 8 be withdrawn.

CONCLUSION


In view of the foregoing, it is respectfully asserted that all of the claims pending in this patent application are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 439.6500. Reconsideration of this patent application and early allowance of all the claims is respectfully requested.

Any fees or extensions of time believed to be due in connection with this amendment are enclosed herein; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-3130.

Dated: _____

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Respectfully submitted,



James J. Lynch

Reg. No. 50,153

Berkeley Law and Technology Group, LLC**1700 NW 167th Place, Suite 240****Beaverton, OR 97006****503.439.6500**